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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,512	10/24/2003	Tor McPartland	57974-5006	9303

7590 05/18/2006

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EXAMINER

PRYOR, ALTON NATHANIEL

ART UNIT PAPER NUMBER

1616

DATE MAILED: 05/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/692,512	MCPARTLAND, TOR	
	Examiner	Art Unit	
	Alton N. Pryor	1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 01 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-6 and 9-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-6 and 9-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

I. Applicant's arguments, see paper, filed 3/1/06, with respect to the rejection(s) of claim(s) under art rejections have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made below.

A. Applicant argues that references cited include substances that are not food grade but are harmful and / or irritant, and therefore would not meet the limitation as set forth by the claims as being food grade. Applicant provides MSDSs to support his argument. Examiner argues that d-limonene instantly claimed as the active ingredient in the present invention is also toxic, harmful if ingested and an irritant as disclosed by the MSDS attached to this office action. Therefore, Examiner argues that Applicant claims containing d-limonene do not meet the claim requirement of being food grade.

B. Applicant has amended claims to include "polyethoxylated castor oil". Examiner has retrieved prior art which would suggest the inclusion of polyethoxylate castor oil in instant invention. See art rejections below.

C. Double Patenting rejection over USPN 6784211 will not be maintained because instant claim 25 has been cancelled. Double Patenting rejection over 10/235450 will not be maintained, because a terminal disclaimer submitted by applicant overcomes this rejection.

II. New Rejections

Claim Rejections - 35 USC § 112

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Claims 1-6,9-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant makes claim to a food grade insecticide which includes d-limonene. However, d-limonene according to the enclosed MSDS is harmful if ingested and therefore would not be considered a food grade ingredient as required by the limitation "food grade" of the instant claims.

Claim Rejections - 35 USC § 103

Claims 1-6,9-11, 13-17, 22,23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dotolo (US 4379168; 4/5/83) in further view of Van Tonder (US 5194264; 3/16/93). Dotolo teaches a composition comprising 20 % d-limonene, 4 % emulsifier, and remainder water (76 %). See Example 14. Dotolo teaches that the d-limonene contains a preservative. See column 6 lines 40-43. Dotolo teaches that the composition can repel or kill insects. See column 7 lines 34-43. Dotolo teaches that the composition controls lice. See column 7 lines 3-4. Dotolo teaches a method of applying the composition to house surfaces such as walls and floors and to animals as a topical application. See column 7 lines 5-11. Dotolo teaches that the composition can be made by the simple act of mixing d-limonene, emulsifier, and remainder water. See claims 34-36. Dotolo teaches all that is recited in claims except for the invention comprising 1) a polyethoxylated castor oil and 2) amount (0.01-5%) of preservative. However, Van Tonder teaches an aqueous formulation comprising pesticide effective against

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ectoparasites. See abstract, column 1 line 4 – 46. Van Tonder teaches that the composition may comprise one or more surfactants including polyethoxylated castor oil. See column 1 line 46 – column 3 line 55. See 6 line 14 – column 7 line 2. Van Tonder teaches a method of applying the composition comprising PEG-castor oil to animals to control ectoparasites (lice). See 6 line 14 – column 7 line 2. It would have been obvious to one having ordinary skill in the art to modify the invention taught by Dotolo to include PEG-castor oil taught by Van Tonder. One would have been motivated to do this.

However, Van Tonder teaches an aqueous formulation comprising pesticide effective against ectoparasites. See abstract, column 1 line 4 – 46. Van Tonder teaches that the composition may comprise one or more surfactants including polyethoxylated castor oil. See column 1 line 46 – column 3 line 55. Van Tonder teaches that the formulation can be made to be used topically to control lice. See 6 line 14 – column 7 line 2. Van Tonder teaches a method of applying the composition comprising PEG-castor oil to animals to control ectoparasites (lice). See 6 line 14 – column 7 line 2. It would have been obvious to one having ordinary skill in the art to modify the invention taught by Dotolo to include PEG-castor oil taught by Van Tonder. One would have been motivated to do this in order to enhance the consistency of the composition and because both inventions independently are to the control of lice on animals. It would have been obvious to one having ordinary skill in the art to determine the optimum amount of preservative to include in the composition. One would have been motivated to do this in order prevent the composition from becoming rancid.

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Claims 1-3,6,7,9,11-15,20,21,24 are rejected under 35 U.S.C. 102(b) as being obvious over Liebman (CA 2060594; 8/6/92) in further view of Van Tonder (US 5194264; 3/16/93). Liebman teaches a method of applying a shampoo or lotion composition comprising d-limonene, emulsifiers (cocoamido propyl betaine, sodium lauryl sulphate, ethyl methacrylate) and water and / or alcohol to human head / hair / skin to contact lice. Leibman teaches that the method is used to prevent lice infestation in human hair and on skin. See page 1 lines 5-8, page 3 lines 5-22, page 6 examples. Liebman teaches all that is recited in claims except for the invention comprising 1) a polyethoxylated castor oil and 2) instant amounts / ranges of ingredients: d-limonene, emulsifying agent, and hydrophilic solvent. However, Van Tonder teaches an aqueous formulation comprising pesticide effective against ectoparasites. See abstract, column 1 line 4 – 46. Van Tonder teaches that the composition may comprise one or more surfactants including polyethoxylated castor oil. See column 1 line 46 – column 3 line 55. Van Tonder teaches that the formulation can be made to be used as a shampoo and that the formulation is effective against lice. See 6 line 14 – column 7 line 2. Van Tonder teaches a method of applying the shampoo composition comprising PEG-castor oil to animals to control ectoparasites (lice). See 6 line 14 – column 7 line 2. It would have been obvious to one having ordinary skill in the art to modify the invention taught by Liebman to include PEG-castor oil taught by Van Tonder. One would have been motivated to do this in order to enhance the consistency of the shampoo and because both inventions independently are to the control of lice on animals. With respect to the amount / ranges of ingredients, one having ordinary skill in the art would have been

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expected to determine the optimum amounts / ranges of ingredients. One would have been motivated to do this in order to develop a lotion that would have been effective in killing lice, but yet non-toxic to animals being treated.

Claims 1,2,6,7,9,11-15,17-19,21,24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilkins, Jr. (US 5951991; 9/14/99) and Van Tonder (US 5194264; 3/16/93). Wilkins, Jr. teaches a method of applying a composition comprising 2-10 % d-limonene, 1-10 % emulsifier, and 80-96 % water to crop or plants to control fire ant infestation. See abstract, column 2 line 1- column 3 line 35. Wilkins, Jr. does not teach 1) the invention comprising a polyethoxylated castor oil and 2) the invention comprising instant amounts / ranges of ingredients: d-limonene, emulsifying agent, and hydrophilic solvent, 3) the plants being rose bushes and ornamentals. However, Van Tonder teaches an aqueous formulation comprising pyrethroid pesticide. See column 1 line 4 – 46. Van Tonder teaches that the composition may comprise one or more surfactants including polyethoxylated castor oil. See column 1 line 46 – column 3 line 55. Van Tonder teaches that the formulation can be made to be used for application to plants. See 3 line 65 – column 4 line 55. Van Tonder teaches a method of applying the composition comprising PEG-castor oil to plant to control pests. See 3 line 65 – column 4 line 55. It would have been obvious to one having ordinary skill in the art to modify the invention taught by Wilkins, Jr. to include PEG-castor oil taught by Van Tonder. One would have been motivated to do this in order to enhance the consistency of the composition and because both inventions independently are to the control of pests on plants. Wilkins, Jr. teaches 2-10% d-limonene; whereas, the instant claims uses a high

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of 1.5% d-limonene. In the absence of unexpected results, one having ordinary skill in the art would expect Wilkins' composition comprising 2% d-limonene to yield similar if not the same results as the instant composition comprising 1.5% d-limonene which is just slightly below 2%. With respect to the amount / ranges of ingredients, one having ordinary skill in the art would have been expected to determine the optimum amounts / ranges of ingredients. One would have been motivated to do this in order to develop a composition that would have been effective in killing insects, but yet non-toxic to humans. With respect to rose bushes and ornamentals, said plants are species within the plant genus; the instant method to said named plants. One would have been motivated to do this since rose bushes and ornamentals are species within the plant genus. Note USPN 5154018 discloses that pyrethroids control fire ants. Therefore, although Van Tonder does not explicitly disclose that pyrethroids control fire ants, said control by pyrethroids is inherent by the class of compounds.

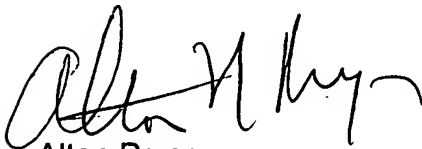
Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Alton Pryor', is written over the printed name.

Alton Pryor
Primary Examiner
AU 1616